UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/202,681	12-23-1999	ERIC J. MATHUR	09010-044001	3238

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EXAMINER
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ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 04-09-2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Advisory Action	09/202,681	MATHUR ET AL.
	Examiner	Art Unit
	Richard G Hutson	1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

<u>PERIOD FOR REPLY</u> [check either a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on <u>23 January 2002</u>. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: <u>1-11</u>.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____.

Continuation of 2. NOTE: Applicants proposed amendment raises additional 112 2nd issues. Applicants proposed deletion of "the group consisting of" makes the claims 1, 10 and 11 unclear, it is suggested that for the clarity of the claims this not be deleted. Further applicants amendment of claims 1 c) and 2 c) such that the isolated "...polynucleotide of (a) or (b) encodes a polypeptide having activity as a thermostable phosphatase..." is unclear in that (b) cannot encode a phosphatase by virtue that it is the complement of (a).
Further applicants amendment of claims 2 and 5 (c) in its recitation of "... enzymatically active fragment thereof." It is unclear how portions (a) and (b) can encode anything other then the full length thermostable phosphatase, and thus the reference to "enzymatically active fragments thereof" is unclear when referring to portions (a) and (b).
Further applicants amendment of claim 5 reciting "...and encodes a thermostable phosphatase" is unclear in that it is not certain to what applicants refer.
Further applicants amendment of claim 10 to refer to claim 1 (a) and (b) but only contain portions (c) and (d) is unclear.

Further the conditions under which the claimed polynucleotides "hybridize " are unclear and therefore raises additional questions as to the asserted function of the claimed polynucleotides. Further applicant is referred to previous discussion of the use of a "comma" and a "semicolon" in claim 1, as it applies to applicants proposed amendment of claim 1 (See also claim 5).

Continuation of 5. does NOT place the application in condition for allowance because: Applicants continue to traverse the rejection of claims 1-11 under 112 1st paragraph as if the rejection was only based on a lack of an enabling disclosure. Applicant is reminded that the rejected claims are rejected under both a lack of scope of enablement and a lack of adequate written description. Applicants submit that the specific function of the claimed polynucleotides is that they have specific utility in an assay as a probe for identifying a nucleic acid sequence that encodes a phosphatase. As previously stated the limitation that they hybridize to specific polynucleotides may be a sufficient structural description of the claimed polynucleotides, but does not define the claimed polynucleotides functionally. Many polynucleotides may hybridize to a polynucldotide that encodes a thermostable phosphatase, but this in and of itself does not functionally describe those polynucleotides adequately. The mere limitation that a polynucleotide hybridizes to a polynucleotide that encodes a phosphatase does not necessarily mean that the claimed polynucleotide is useful in an assay as a probe for the identification of nucleotides.
Applicants further submit that claim 10 which is drawn to a thermostable phosphatase which comprises as little as 30 contiguous amino acid residues of the enzyme of part (a) of the claim, has a nexus of structure and function   This is not found persuasive because applicants are reminded that the claimed genus includes not only those thermostable phosphatases which comprise 30 contigulus amino acid residues of SEQ ID NO: 28 , but the claimed genus includes those thermostable phosphatases which comprises at least 30 contiguous amino acid residues, of those thermostable phosphatases which are at least 70 % identical to SEQ ID NO: 28.

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